UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,189	07/22/2002	Kenji Iwano	MTS -3315US	1511

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EXAMINER
PASS, NATALIE

ART UNIT	PAPER NUMBER
3626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/088,189	IWANO ET AL.
	Examiner	Art Unit	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 July 2002 and 08 February 2007</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-30</u> is/are pending in the application.

     4a) Of the above claim(s) <u>7-12, 17-20, and 25-28</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-6, 13-16, 21-24, 29 and 30</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date <u>9 March 2006</u>.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

Notice to Applicant

1.   This communication is in response to the application filed 22 July 2002 and the

Responses to Restriction Requirement filed 8 February 2007. The IDS statement filed 9 March

2006 has been entered and considered and substituted for the IDS statement filed 14 March 2002,

which contained errors. Claims 1-30 are pending. Claims 1-6, 13-16, 21-24, and 29-30 have been

elected without traverse. Claims 7-12, 17-20, and 25-28 are withdrawn from further

consideration by the Examiner, pursuant to 37 CFR 1.142(b), as being drawn to a non-elected

invention.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

3.   Claims 15-16, 21-24, and 29-30 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

(A)   Claims 15, 21 recite "in a medical information system in accordance with claim 1,

[13], programs for activating a computer…" in the preamble, however claim 1 recites a medical

information system. As such, it is unclear whether applicant seeks patent protection for a system

or for a program. Please note MPEP section 2106. For the purpose of finding art, Examiner

interprets the claim to recite a program.

(B)   Claims 16, 22 recite "in a patient terminal device in accordance with claim 4, [14] programs for activating a computer..." in the preamble, however claim 4 recites a patient terminal device. As such, it is unclear whether applicant seeks patent protection for a device or for a program. Please note MPEP section 2106. For the purpose of finding art, Examiner interprets the claim to recite a program.

(C)   Claim 23 recites "in a medical information system in accordance with claim 1, a computer processable medium ..." in the preamble, however claim 1 recites a medical information system. As such, it is unclear whether applicant seeks patent protection for a system or for a computer processable medium. Please note MPEP section 2106. For the purpose of finding art, Examiner interprets the claim to recite a computer processable medium.

(D)   Claim 24 recites "in a patient terminal device in accordance with claim 4, a computer processable medium ..." in the preamble, however claim 4 recites a patient terminal device. As such, it is unclear whether applicant seeks patent protection for a device or for a computer processable medium. Please note MPEP section 2106. For the purpose of finding art, Examiner interprets the claim to recite a computer processable medium.

(E)   Claim 29 recites "in a medical information system in accordance with claim 13, a computer processable medium ..." in the preamble, however claim 13 recites a medical information system. As such, it is unclear whether applicant seeks patent protection for a system or for a computer processable medium. Please note MPEP section 2106. For the purpose of finding art, Examiner interprets the claim to recite a computer processable medium.

. (F)   Claim 30 recites "in a patient terminal device in accordance with claim 14, a

computer processable medium ..." in the preamble, however claim 14 recites a patient terminal

device. As such, it is unclear whether applicant seeks patent protection for a device or for a

computer processable medium. Please note MPEP section 2106. For the purpose of finding art,

Examiner interprets the claim to recite a computer processable medium.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1, 13-15, 21-23, 29 are rejected under 35 U.S.C. 102(e) as being anticipated by

Hacker, United States Patent 6, 988, 075.

(A)   As per claim 1, Hacker teaches a medical information system comprising patient

terminal devices (Hacker; Figure 1, Item 102), a central control device (Hacker; Figure 1, Item

120) and data browsing terminal devices (Hacker; Figure 1, Items 140)

wherein said patient terminal devices, said central control device and said data

browsing terminal devices are connected on a network (Hacker; Figure 1, column 6, lines 20-

23),

said patient terminal device has means of transferring vital information relating to the

health condition of a patient to said central control device via said network and means of

receiving control information from said central control device (Hacker; Figure 1, column 6,

lines 53-59, column 10, lines 4-8),

said central control device has means of storing (Hacker; column 6, lines 14-17) said

vital information transferred from said patient terminal device and arranging said information to

information having anonymity (Hacker; column 13, lines 44-46), and

said data browsing terminal device has means capable of browsing all or parts of said

vital information stored and arranged in said central control device (Hacker; Figure 3, column 6,

lines 14-17, 20-23).

(B)   Claim 13 differs from claim 1 by reciting a medical information system

comprising patient terminal devices, a central control device, data browsing terminal devices and

a data replication terminal device rather than a medical information system comprising patient

terminal devices, a central control device and data browsing terminal devices.

As per the recital in claim 1 of a data replication device, Examiner interprets Hacker's

descriptions and teachings of data storage and backup strategies that copy data from one

computer to another in order to backup data, as, for example, in Hacker's teachings of

"coordinating updates to medical database in a medical information system that permits

concurrent charting from different workstations and medical instruments. A first data value for a

record is entered at a first workstation and a second data value for the record is entered at a

second workstation without locking either workstation during data entry. The new data values

are stored in the medical database after completion of data entry at each workstation, and a

correction history is recorded. The correction history contains information as to the update of the

record with the first data value and the second data value. The record is updated with the first

and second data values without aborting user activities or notifying a user that an update conflict

has occurred. After the new data values are stored in the medical database, all workstations

containing a copy of the record are updated to reflect the current state of the record" (Hacker;

column 3, lines 45-62) to teach a form of data replication terminal devices. The remainder of

claim 13 repeats the features of claim 1, and is therefore rejected for the same reasons given

above in the rejections of claim 1, and incorporated herein.

(C)   Apparatus claim 14 repeats the subject matter of system claim 13, respectively, as

a set of "means-plus-function" elements rather than a series of elements. As the underlying

processes of claim 13 have been shown to be anticipated in view of the teachings of Hacker in

the above rejections of claim 13, it is readily apparent that the apparatus disclosed by Hacker

includes the apparatus to perform these functions. As such, these limitations are rejected of the

same reasons given above for system claim 13, and incorporated herein.

(D)   Claim 15 differs from system claim 1 by reciting "programs for activating a

computer ..." in the preamble. As per this limitation, Hacker clearly discloses his invention to be

implemented using "programs for activating a computer..." (Hacker; column 7, lines 33-40).

The remainder of claim 15 repeats the limitations of claim 1, and is therefore rejected for the

same reasons given above for claim 1.

(E)   Claim 21 differs from system claim 13 by reciting "programs for activating a

computer ..." in the preamble. As per this limitation, Hacker clearly discloses his invention to be

implemented using "programs for activating a computer..." (Hacker; column 7, lines 33-40).

The remainder of claim 21 repeats the limitations of claim 13, and is therefore rejected for the

same reasons given above for claim 13.

(F)   Claim 22 differs from claim 14 by reciting "programs for activating a computer

..." in the preamble. As per this limitation, Hacker clearly discloses his invention to be

implemented using "programs for activating a computer..." (Hacker; column 7, lines 33-40).

The remainder of claim 22 repeats the limitations of claim 14, and is therefore rejected for the

same reasons given above for claim 14.

(G)   Claim 23 differs from system claim 1 by reciting "a computer processable

medium ..." in the preamble. As per this limitation, Hacker clearly discloses his invention to be

implemented using "a computer processable medium ..." (Hacker; column 7, lines 33-40). The

remainder of claim 23 repeats the limitations of claim 1, and is therefore rejected for the same

reasons given above for claim 1.

(H)   Claim 29 differs from system claim 13 by reciting "a computer processable

medium ..." in the preamble. As per this limitation, Hacker clearly discloses his invention to be

implemented using "a computer processable medium ..." (Hacker; column 7, lines 33-40). The

remainder of claim 29 repeats the limitations of claim 13, and is therefore rejected for the same

reasons given above for claim 13.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claims 2-4, 16, 24, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Hacker, United States Patent 6, 988, 075 as applied to claim 1 above, and further in view of Doi

et al., United States Patent 6, 221, 009.

(A)   As per claim 2, Hacker teaches a system as analyzed and discussed in claim 1

above.

Hacker fails to explicitly disclose a system wherein said patient terminal device has

sensors for measuring said vital information relating to the health condition of said patient.

However, the above features are well-known in the art, as evidenced by Doi.

In particular, Doi teaches a system wherein said patient terminal device has sensors for

measuring said vital information relating to the health condition of said patient (Doi; column 4,

lines 55-67, column 5, lines 12-17).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the system of Hacker to include these limitations, as taught by Doi, with the

motivations of providing "more sophisticated health care to individual patients" (Doi; column 2,

lines 18-24).

(B)   As per claim 3, Hacker teaches a system as analyzed and discussed in claim 1

above.

Hacker fails to explicitly disclose a system wherein said arranged information is

statistical data.

However, the above features are well-known in the art, as evidenced by Doi.

In particular, Doi teaches a system wherein said arranged information is statistical data

(Doi; column 5, lines 47-51).

The motivations for combining the respective teachings of Hacker and Doi are as given

in the rejection of claim 2 above, and incorporated herein.

(C)   As per claim 4, Hacker and Doi teach patient terminal devices mutually connected

to a central control device and data browsing terminal devices on a network, comprising:

means, having a function of measuring vital information relating to the health condition

of a patient, of transferring said vital information to said central control device via said network

(Doi; column 2, lines 30-40, column 4, lines 55-67, column 5, lines 12-17), and

means of receiving control information from said central control device (Hacker; Figure

1, column 6, lines 53-59, column 10, lines 4-8), wherein

said central control device has means of storing (Hacker; column 6, lines 14-17) said

vital information transferred from said patient terminal device and arranging said information to

information having anonymity (Hacker; column 13, lines 44-46), and

said data browsing terminal device has means capable of browsing all or parts of said

vital information stored and arranged in said central control device (Hacker; Figure 3, column 6,

lines 14-17, 20-23).

The motivations for combining the respective teachings of Hacker and Doi are as given in

the rejection of claim 2 above, and incorporated herein.

(D)   Claim 16 differs from system claim 2 by reciting "programs for activating a

computer ..." in the preamble. As per this limitation, Hacker clearly discloses his invention to be

implemented using "programs for activating a computer..." (Hacker; column 7, lines 33-40).

The remainder of claim 16 repeats the limitations of claim 6, and is therefore rejected for the

same reasons given above for claim 6.

The motivations for combining the respective teachings of Hacker and Doi are as given in

the rejection of claim 2 above, and incorporated herein.

(E)   Claim 24 differs from system claim 2 by reciting "a computer processable

medium ..." in the preamble. As per this limitation, Hacker clearly discloses his invention to be

implemented using "a computer processable medium ..." (Hacker; column 7, lines 33-40). The

remainder of claim 24 repeats the limitations of claim 2, and is therefore rejected for the same

reasons given above for claim 2.

The motivations for combining the respective teachings of Hacker and Doi are as given in the rejection of claim 2 above, and incorporated herein.

(F)   Claim 30 differs from claim 16 by reciting "a computer processable medium ..." in the preamble. As per this limitation, Hacker clearly discloses his invention to be implemented using "a computer processable medium ..." (Hacker; column 7, lines 33-40). The remainder of claim 30 repeats the limitations of claim 16, and is therefore rejected for the same reasons given above for claim 16.

The motivations for combining the respective teachings of Hacker and Doi are as given in the rejection of claim 2 above, and incorporated herein.

8.   Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker, United States Patent 6, 988, 075 as applied to claim 1 above, and further in view of Berson, United States Patent 6, 532, 459.

(A)   As per claims 5-6, Hacker teaches a system as analyzed and discussed in claim 1 above.

Although Hacker teaches display means and data browsing terminal devices (Hacker; Figure 1, Item 102), Hacker fails to explicitly disclose a system

wherein, when said vital information is browsed from said data browsing terminal device, money is charged by said central control device to the person who browses; and

having means of displaying advertisement data at the same time when said vital

information is browsed from said data browsing terminal device, wherein money is charged to

the advertiser thereof on the basis of the number of times said advertisement data is displayed.

However, the above features are well-known in the art, as evidenced by Berson.

In particular, Berson teaches a system

wherein, when said vital information is browsed from said data browsing terminal device,

money is charged by said central control device to the person who browses (Berson; column 9,

lines 33-36, column 11, lines 50-60); and

having means of displaying advertisement data at the same time when said vital

information is browsed from said data browsing terminal device wherein money is charged to

the advertiser thereof on the basis of the number of times said advertisement data is displayed

(Berson, column 3, lines 54-57, column 4, lines 30-32); Examiner interprets Berson's teachings

of "includes a *capability for determining fees based upon information content, location, and

database ownership" (Berson; column 4, lines 30-32) to be a form of "money is charged to the

advertiser thereof on the basis of the number of times said advertisement data is displayed."

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the system of Hacker to include these limitations, as taught by Berson, with

the motivations of providing "a system for use by an individual that enables him to search, find,

identify, track, and correct personal information about himself that is held in diverse external

databases on computer networks" (Berson; column 2, lines 21-25).

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to Applicant's

disclosure. The cited but not applied references Huff, U.S. Patent Number 6760731, Szabi U.S.

Patent Number 5966126, Cooney, U.S. Patent Application Publication Number 2002/0107700,

Linberg, et al., U.S. Patent Application Publication Number 2001/0039504, Albert, et al., U.S.

Patent Application Publication Number 2001/0023316, and Edelson et al., U.S. Patent Number

5737539 teach the environment of electronic transmittal of medical data.

10.   Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: **(571) 273-8300**.

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.
After Final communications should be labeled "Box AF."

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The

examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The

examiner can also be reached on alternate Fridays.

12.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or

relating to the status of this application or proceeding should be directed to the Receptionist

whose telephone number is (571) 272-3600.

13.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Natalie A. Pass

March 16, 2007

Carolyn Bleck
Patent Examiner 3626
3/17/07